

REMARKS

Applicant requests withdrawal of the finality of the present rejection. The present claims are newly rejected based upon art, U.S. Patent No. 5,409,953, that has been of record since 3 June 2004, but has not been the basis of a rejection until the present Final Office Action. This rejection was not caused by Applicant's amendment of the claims, nor because the art is newly of record, as Applicant submitted the reference to the Office nearly six years ago. While Applicant appreciates the Office's desire to avoid undue elongation of prosecution, the Finality of the present Office Action deprives Applicant of its right to fully address the new rejection.

Applicant respectfully requests reconsideration of the present application in view of the reasons that follow. Claims 10, 12, 34, 38 and 41 are amended as discussed below. Claims 38 and 41 are amended to correct a numbering error resulting from a prior amendment. After entrance of the present amendment, claims 4, 10, 12-16, 34-42, 57 and 58 remain pending.

35 U.S.C. § 112, second paragraph

Claims 12-15 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite, due to the dependency of claim 12. Claim 12 is corrected to depend from claim 10.

35 U.S.C. § 102 - anticipation

Claims 10, 12, 34, 38, 39, 41 and 42 [previously 4, 10-16, 34-42] stand rejected under 35 U.S.C. § 102(b) as being anticipated by Blum, et al., *Biochemistry* 39:15705-15712 (2000). Applicant notes that the rejection of claims 4, 13-16, 35-37 and 40 as being anticipated appears to be withdrawn.

Claims 10 and 34 are amended to remove hydroxyl as a potential substituent, except as necessary to form the single catechol moiety of the compounds of the invention. Accordingly, Blum, et al. does not anticipate the presently claimed invention. Application respectfully requests withdrawal of the present rejection.

Claims 4, 10, 12-16, 34-39, 41, 42, 57 and 58 are newly rejected under 35 U.S.C. § 102(b) as being anticipated by US 5,409,953. The Office simply states “’953 teaches combretastatin compounds with -OCH₃ or -OH in the herein recited position (see for example the abstract).”

First Applicant notes that while this reference has been of record in this application since 3 June 2004, this rejection is newly raised in a Final Office Action. There is no indication that this rejection is necessitated by Applicant’s amendment. Indeed, the scope of the present claims is no broader than that pending in previous office actions. Therefore, Applicant sees no reason that the Office has waited until the fourth Office Action on the merits to newly raise this reference.

Second, Applicant is unclear what the Examiner intends by “the herein recited position.” Applicant believes that the Examiner may be referring to the disclosure of combretastatin A-1 in the ‘953 patent. Applicant notes that claims 4 and 10 explicitly exclude combretastatin A-1, salts, esters, and prodrugs thereof from the claim. Claim 34 is amended to include this proviso. Support for the amendment of claim 34 can be found throughout the application, including at page 4, lines 12-13.

Double Patenting

Claims 1-4, 10-16, 34-42 and 57 stand rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-5 of U.S. Patent No. 6,919,324. The terminal disclaimer submitted herewith overcomes this rejection.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-4279. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-4279. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-4279.

Respectfully submitted,

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